

from the ring. It is not a discontinuity. It mates with the “edge discontinuity shape of the wafer.” Therefore, Stroupe neither teaches nor suggests the above-quoted limitation of claim 1.

On June 16, 2005, Applicants’ attorney and the Examiner had a telephone interview concerning the meaning of the term “discontinuity.” The Examiner argued that during examination, claims are construed broadly. However, MPEP §2111.01 specifically states that this rule of claim interpretation does not apply where Applicant has provided a definition in the specification. The term “discontinuity” is defined in Application ¶21 as follows:

As used herein, the term “discontinuity” encompasses a gap such as gap 26g. The term ‘discontinuity’ also encompasses a situation in which end 26a is flush against end 26b....

Stroupe structure 48 does not fall within the meaning of discontinuity as explained above. Therefore, again, Stroupe cannot anticipate claim 1.

Claims 2-4 and 9-11 distinguish over Stroupe for at least the reason set forth above.

## II. New Claims 17-24 Are Patentable Over Stroupe

Applicants have added new claims 17-24. Even if one were to construe the word “discontinuity” as the Examiner has done, claims 17-24 clearly distinguish over Stroupe.

### III. Claim 12 is Patentable Over the Combination of Stroupe and Kai

The Office Action rejects claim 12 over Stroupe and Kai. (Office Action page 3.)

Claim 12 is patentable over Stroupe combined with Kai for at least the reason set forth above with respect to claim 1.

### IV. Claims 5 and 13 Are Patentable Over the Combination of Stroupe and Lee

The Office Action rejects claims 5 and 13 over Stroupe combined with Lee.

Office Action, page 3. Claims 5 and 13 are patentable over this combination for at least the reasons set forth above with respect to claim 1.

Claims 5 and 13 are also patentable over the cited art because there is no reason one skilled in the art would combine Stroupe and Lee. The Office Action states:

Stroupe does not disclose inserted a member into a hole of the workpiece. However, Lee teaches inserted a disk member into a hole of a disk-shaped workpiece in order to properly mount the workpiece. Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to use an insertion member, as taught by Lee, in the apparatus disclosed by Stroupe in order to properly mount workpieces having a central hole.

Office Action, pages 3-4. This is incorrect. Stroupe's wafer 32 does not have a hole.

There is no reason one skilled in the art would provide Lee's alleged member extending through Stroupe's hole, because Stroupe's hole doesn't exist. Further, there is no reason one skilled in the art would be motivated to provide a hole in Stroupe's semiconductor wafer. Therefore, it could not possibly be obvious to combine Stroupe and Lee.

### V. Claims 6-8 and 14-16 Distinguish Over Lee.

The Office Action rejects claims 6-8 and 14-16 as anticipated by Lee. The Office Action states: "Lee discloses polishing a disk-shaped workpiece within an opening of a

carrier wherein a disk member is inserted into hole of disk workpiece and polished by member (33).”<sup>1</sup> Office Action, page 3. Applicants have amended claims 6 and 14 to overcome this rejection as applied to claim 6 and 14.

Applicants have rewritten claims 7 and 15 in independent form and traverse this rejection as it is applied to claims 7 and 15. (Applicants have removed a limitation from claim 7 and placed that limitation in claim 8. Applicants have also removed a limitation from claim 15 and placed it in claim 16.)

A. Claims 6 and 14 as Amended Distinguish Over Lee.

Claim 6 now recites:

a member inserted into said opening of said workpiece; and

at least one polishing pad for polishing at least one surface of said workpiece, said polishing pad extending over said workpiece, said opening and said member

Even if one assumes that Lee teaches a member within the opening of his optical disk, as can be seen in Lee Fig. 6, structure 33 (alleged to correspond to Applicants’ polishing pad) does not extend over the opening in the optical disk and the member. Therefore, Lee does not anticipate claim 6. Further, there is nothing in Lee to teach or suggest extending structure 33 over the opening in his optical disk. Therefore, Lee cannot render obvious Applicants’ claim 6.

Claims 8, 14 and 16 distinguish over Lee for similar reasons.

B. Claims 7 and 15 Distinguish Over Lee.

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<sup>1</sup> Applicants’ attorney assumes that the Office Action alleges that Lee structure 33 corresponds to the claimed polishing pad.

Claim 7 requires that “said member prevents or reduces roll-off near the opening of said workpiece”. Lee neither teaches nor suggests this limitation. As explained at Application ¶4,

At the conclusion of polishing, it would be desirable for the substrate 4 to have a profile as shown in cross-section in Fig. 2. Unfortunately, substrates often emerge from the polishing process with a defect called “roll-off”, schematically shown by dotted lines R in Fig. 3, which extends into the data zone 4z. (Data zone 4z is where data will ultimately be recorded on the disk when it is finished.) One cause of roll-off is that substrates 4 have a thickness T4 that is greater than thickness T2 of carrier 2. Therefore, pads 9, 10 tend to push harder against the edges E of substrates 4, thereby causing roll-off. It would be desirable to prevent roll-off.

Lee structure 33 does not extend to the opening in his disk. Therefore, the structure alleged by the examiner to constitute Lee’s member does not prevent or reduce roll-off near the opening of his workpiece as required by claim 7. Therefore, claim 7 distinguishes over Lee.

Claim 15 distinguishes over Lee for at least the reason set forth above with respect to claim 7.

#### VI. Amendment to ¶ 4

Applicant is making a minor non-substantive grammatical correction to Application ¶4. No new matter is being added.

VII. Conclusion

For at least the above-mentioned reasons, the present application is now in condition for allowance. If the Examiner's next action is other than allowance, the Examiner is respectfully requested to telephone Applicants' attorney at (408) 732-9500.

Respectfully submitted,



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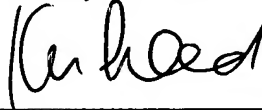
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 13, 2005.

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